



REMARKS

Drawings

1. Drawings were objected to under 37 CFR 1.83(a) because the combination of the hinged clip and the bracket members having resilient members extending into the channel, as recited in claim 15, and the clip being removable from the support member, as recited in claim 19, were not shown in the drawings.
2. Drawings were objected to under 37 CFR 1.84(p)(4) because reference character "42" has been used to designate both the retaining member and money clip, while "54" has been used to identify the curved edge and spring finger.
3. Photocopies of drawing sheets 1/7, 2/7, and 4/7 with changes indicated in red ink as well as a new drawing sheet containing Figs. 13A and 11B are proposed for submission by the Applicant to remedy the defects enumerated in paragraphs 1 and 2, above. A request for approval of proposed drawing amendment is attached. No new matter has been entered.

Specification

4. The disclosure was objected to because reference numeral "34" has been used to describe the *curved edge* and *spring*, "42" has been used to describe the *retaining member* and *clip*, and "54" has been used to describe the *curved edge* and *spring finger*.
5. The specification was objected to as failing to provide proper antecedent basis for the claimed subject matter [37 CFR 1.75(d)(1) and MPEP § 608.01(o)]. The Examiner has indicated that no clear antecedent basis was provided for the clip being removable from the support, as claimed in claim 19.
6. Minor changes to the specification are proposed to rectify the defects enumerated in paragraphs 4 and 5, above, as well as to define with greater clarity the

novel and unobvious features of the invention shown in the drawings. No new matter has been added.

Claim Rejections -- Substantially Duplicative Claims

7. The Examiner has advised that should claim 2 be found allowable, claim 4 will be objected to under 37 CFR 1.75 as a substantial duplicate thereof. Applicant recognizes his oversight in submitting substantially duplicative claims and respectfully requests that claim 2 be canceled without prejudice.

Claim Rejections - 35 U.S.C. § 112

8. Claims 10 and 16-20 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner has indicated that there appears to be no sufficient structure set forth in claims 10 or 16 to form a channel, as claimed.

9. Applicant respectfully submits that claims 10 has been canceled and that claim 16 has been amended to a scope commensurate with the support of the specification to obviate the rejections under 35 U.S.C. 112, second paragraph. No new matter has been entered. Since claims 17-20 depend from independent claim 16, the amendment of the independent claim should remove the indefiniteness rejections with respect to claims dependent therefrom.

Claim Rejections - 35 U.S.C § 103

10. Claims 1-4, 9, 16-18, and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,520,230 to Yancey Sumner, III, hereinafter Sumner, in view of U.S. Patent 3,100,494 to W.I. Littman, hereinafter Littman. The Examiner has stated that the device claimed by the Applicant is not more than the device of

Sumner, with a stop, and that to have provided it with an item-retaining stop would have been obvious in view of Littman. Applicant respectfully requests that Claim 2 be canceled without prejudice. The remaining claims 1, 3, 4, 9, 16-18, and 20 are submitted to be patentable over the prior art of record at least for the reasons provided in paragraphs 11-15, below.

11. Sumner discloses a one-piece pocket holder for carrying rigid plastic cards, where "the distance between channels 10L and 10R is *the width of the cards* desired to be retained" (column 2, lines 23-24). Because of the above-described geometry of the channels, "the cards are *held securely in place* by card channels 10L, 10R" (column 2, lines 54-55). "To insert the cards into the holder (Fig. 2), grasp the holder between the thumb and forefinger of one hand by the spring end 12 with card channels 10L, 10R facing you. With the other hand, two or three rigid plastic cards stacked one upon another are *placed flat upon the lip 16* and inserted into the channels 10L, 10R" (column 2, lines 47-53). "To extract cards, the holder is held firmly between the thumb and forefinger of the one hand with the cards facing you. With the thumb and forefinger of the other hand, grasp the cards and *pull the cards out of the channels*" (column 2, lines 56-59).

12. Littman provides a combination money clip and change holder where "one end 21 of blank 11 is folded along the fold line 22 to provide an end closure" (first stop) "to preclude the *slippage of coins out of the sides* of the device, such *slippage at the other end* being precluded by the reverted portion 13" (second stop) "of the tongue 12" (column 2, lines 4-6).

13. According to MPEP 2141.01, "It is difficult but necessary that the decisionmaker forget when he or she has been taught ... about the claimed invention and cast the mind back to the time the invention was made ... to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art". *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721

F.2d-1540, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Under MPEP 2145, a judgment on obviousness is proper "so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure...". *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

14. As stated in MPEP 2143.01, the mere fact that references can be combined or modified does not necessarily render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990). Applicant respectfully submits that there is no suggestion in Sumner and Littman that it would be desirable for one of ordinary skill in the art to combine the features disclosed therein. As recited in paragraph 12, above, Littman's stops were provided "to preclude the *slippage of coins out of the sides* of the device" (column 2, lines 5-6). Sumner, however, already discloses that "the cards are *held securely in place* by card channels 10L, 10R" (column 2, lines 54-55), which is possible because "the distance between channels 10L and 10R is *the width of the cards* desired to be retained" (column 2, lines 23-24). Thus, no suggestion exists in the prior art of record to incorporate Littman's slippage-preventing stops into Sumner's holder because the contents of Sumner's holder are already securely retained within the channels thereof. In fact, the structure and function disclosed by Sumner teach away from the aforementioned combination. Accordingly, it would not be obvious for one of ordinary skill in the art to combine the features of Sumner and Littman because there is no suggestion in the references themselves that they be combined. Moreover, MPEP 2145, Sec D3, indicates that it is improper to combine references where the references teach away from their combination.

15. Additionally, MPEP 2143.01 states that if the proposed modification would render the prior-art invention being modified unsatisfactory for its intended purpose,

then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Should Littman's slippage-preventing stops be combined with Sumner's holder for the purpose of retention of the cards in Sumner's channel, the latter will be rendered unsatisfactory for its intended purpose because the user will no longer be able to extract the cards from Sumner's holder when "the holder is held firmly between the thumb and forefinger of the one hand" (column 2, lines 56-57) so that one can "with the *thumb and forefinger of the other hand*, grasp the cards and *pull the cards out of the channels*" (column 2, lines 58-59). With Littman's stops placed on both sides of Sumner's retaining channel, the task of extracting the cards from the receptacle would become cumbersome, if not impossible, since the stops prevent the cards from being pulled out in either direction using the thumb and forefinger of one hand, as originally contemplated by the inventor, and Sumner's device would thus become unsatisfactory for its intended purpose of allowing convenient withdrawal of items therefrom. Similarly, if Littman's stops were combined with Sumner's holder, it would no longer be possible to insert the cards in Sumner's receptacle so that with one hand the cards are "*placed flat upon the lip 16* and inserted into channels 10L, 10R" (column 2, lines 52-53). Therefore, since the combination of Littman's stops with Sumner's receptacle renders the latter unsatisfactory for its intended purpose, namely, quick and easy insertion and extraction of the receptacle's contents, the prior art provides no suggestion or motivation to make the proposed modification.

16. Claim 5 was rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 4, and further in view of British Patent 274,969 to G. W. Wheeler, hereinafter Wheeler. The Examiner has stated that to have provided the channels of Sumner, with retaining fingers to secure items, would have been obvious in view of Wheeler. Claim 5 is respectfully submitted to be patentable over the prior art of record at least because it depends from claim 4, which is believed to be in condition

for allowance. Additional reasons demonstrating that claim 5 is patentably distinguishable over the prior art are provided in paragraphs 17 and 18, below.

17. Wheeler teaches a visiting-card holder having "a substantially U-shaped frame, having limbs of channel-section within each of which limbs is disposed a *leaf-spring*, one of which is laterally bowed..." (column 3, lines 39-42). "The spring is sufficiently strong to *retain the cards g in position in the frame* whilst they are being carried about..." (column 4, lines 93-98).

18. As discussed in paragraph 14, above, the mere fact that references can be combined or modified does not necessarily render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Applicant respectfully submits that there is no suggestion in the prior art of record that it would be desirable for one of ordinary skill in the art to combine the features disclosed therein. As recited in paragraph 17, above, in Wheeler's visiting-card holder "the spring is sufficiently strong to *retain the cards g in position in the frame* whilst they are being carried about..." (column 4, lines 93-98). Sumner, however, already discloses that "the cards are *held securely in place* by card channels 10L, 10R" (column 2, lines 54-55), which is possible because "the distance between channels 10L and 10R is *the width of the cards* desired to be retained" (column 2, lines 23-24). Thus, no suggestion exists in the prior art of record to incorporate Wheeler's card-retaining spring into Sumner's holder because the contents of Sumner's receptacle are already securely retained within the channels thereof. In fact, the structure and function disclosed by Sumner teach away from the aforementioned combination. Accordingly, it would not be obvious to combine the features of Sumner and Littman in view of Wheeler because there is no suggestion in the references themselves that they be combined. Moreover, it is improper to combine references where the references teach away from their combination.

19. Claims 6 and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 4 and 17 above, and further in view of U.S. Patent 4,518,080 to K. L. Ohlson, hereinafter Ohlson. The Examiner has stated that to have made the clip removable and provided retaining means in the base would have been obvious in view of Ohlson. Claim 6 has been amended to limit "said means" to "resilient fingers". Basis for this limitation appears on page 5, lines 17-22 of the specification. Claims 6, as amended, and 19 are respectfully submitted to be patentable over the prior art of record at least because they depend from claims 4 and 17, respectively, which are believed to be in condition for allowance. Additional reasons demonstrating that claims 6 and 19 are patentably distinguishable over the prior art are provided in paragraphs 20-22, below.

20. According to MPEP 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

21. Claim 6 is respectfully submitted to be patentable over the prior art of record at least because it recites novel and nonobvious features of "**resilient fingers** formed from the **base** of said holder". Even if the references could be combined in a manner suggested by the Examiner, the combination would not have motivated one of ordinary skill in the art to arrive at the invention as recited in claim 6 since none of the references teach "**resilient fingers** formed from the **base** of said holder".

22. Claim 19 is respectfully submitted to be patentable over the prior art of record at least because it recites novel and nonobvious features of "a removable spring clip extending across said **supporting portion**," (which in turn extends from one of the two transverse edges of the base) "said spring clip being biased to engage said supporting portion, said spring clip having a first section disposed along the **exterior**

of said supporting portion and a second section disposed along the **interior** of said supporting portion...". Ohlson, on the other hand, discloses a card retainer having a "separate and detachable by clamping force acting holding means" (column 4, lines 35-36), which can be attached to the card retainer by virtue of the fact that "the bottom plate 1" (base) "has a central *first recess 15* and a *second identical recess 15a*. These recesses 15, 15a are formed to cooperate with a separate and detachable by clamping force acting holding means, shown in Fig. 4..." (column 4, lines 33-36). Thus, instead of utilizing a separate **supporting portion** having an **exterior**, an **interior**, and extending from the base so that the removable spring clip can engage such supporting portion, as recited in claim 19, Ohlson teaches "*recesses 15, 15a*" for removable engagement with his holding means (clip), the recesses being formed in the bottom plate (base). Consequently, even if the references could be combined in a manner suggested by the Examiner, the combination would not have motivated one of ordinary skill in the art to arrive at the invention as recited in claim 19 since none of the references teach "said spring clip being biased to engage said **supporting portion**...", where such supporting portion extends from the base and has an **exterior** and an **interior**.

23. Claim 7 was rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 4 above, and further in view of U.S. Patent 1,766,599 to Elizabeth Cahill, hereinafter Cahill. The Examiner has stated that to have optionally formed the retaining portion at the top of the channel would have been obvious in view of the fingers taught by Cahill. Claim 7 is respectfully submitted to be patentable over the prior art of record at least because it depends from claim 4, which is believed to be in condition for allowance. Additional reasons demonstrating that claim 7 patentably distinguishes over the prior art are provided in paragraphs 24 and 25, below.

24. Cahill teaches a safety carrier for paper currency, papers, valuables, and keys. Cahill's carrier includes "paper and currency holding fingers" (column 2, line 72). "The

outwardly turned lower ends 2^d of the fingers permit one to slip a folded bill or pieces of paper currency 9 under the resilient fingers 2 and when so inserted the resilient fingers *clamp the same firmly* against the plate 1..." (column 4, lines 74-79).

25. As discussed in paragraph 14, above, the mere fact that references can be combined or modified does not necessarily render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Applicant respectfully submits that there is no suggestion in the prior art of record that it would be desirable for one of ordinary skill in the art to combine the features disclosed therein. As recited in paragraph 24, above, when objects are inserted under the resilient fingers of Cahill's carrier, "the resilient fingers *clamp the same firmly* against the plate 1..." (column 4, lines 77-79). Sumner, however, already discloses that "the cards are *held securely in place* by card channels 10L, 10R" (column 2, lines 54-55), which is possible because "the distance between channels 10L and 10R is *the width of the cards* desired to be retained" (column 2, lines 23-24). Thus, no suggestion exists to incorporate Cahill's resilient fingers into Sumner's holder because the contents of Sumner's receptacle are already securely retained within the channels thereof. In fact, the structure and function disclosed by Sumner teach away from the aforementioned combination. Accordingly, it would not be obvious for one of ordinary skill in the art to combine the features of Sumner and Littman in view of Cahill because there is no suggestion in the references themselves that they be combined. Moreover, it is improper to combine references where the references teach away from their combination.

26. Claim 8 was rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 4, above, and further in view of either U.S. Patent 3,596,757 to Patrick T. Cocchiaraley or U.S. Patent 5,653,276 to Harold A. Niernberger. Claim 8 is respectfully submitted to be patentable over the prior art of

record at least because it depends from claim 1, which is believed to be in condition for allowance.

27. Claims 10-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of U.S. Design Patent 184,679 to William F. Kramer. Applicant respectfully requests that claims 10-12 be canceled without prejudice.

28. The Examiner stated that claims 13-15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in the Office Action mailed April 23, 1999, and to include all of the limitations of the base claim and any intervening claims. As suggested by the Examiner, claim 13 has been amended to include all of the limitations of the canceled base claim 10 and the canceled intervening claims 11 and 12 and to overcome the rejections under 35 U.S.C. 112, 2nd paragraph. No new matter has been introduced. Accordingly, claims 13-15 are submitted to be in condition for allowance.

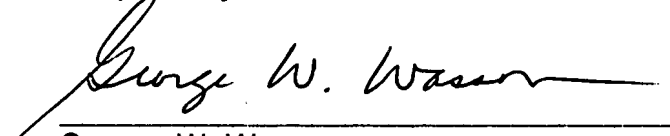
The Cited but Non-applied References

29. The subsidiary references cited by the Examiner have been duly noted.

Conclusion

30. In view of the above, it is submitted that the claims recite novel and unobvious structure and are in condition for allowance. Reconsideration of the rejections and objections is requested. If a telephone discussion with applicant's attorney would assist in the prosecution of this application, the Examiner is invited to call or fax the undersigned at the telephone number below.

Respectfully submitted,



George W. Wasson
Attorney for Applicant
Registration No. 17,685

3121 Indian Way
Lafayette, CA 94549
Tel. and Fax (925) 283-4420

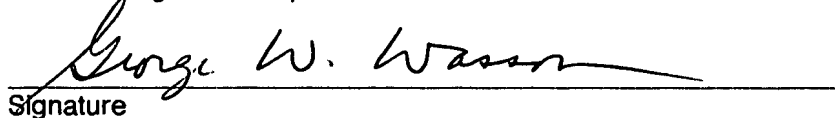
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

on July 22, 1999
(Date of Deposit)

GEORGE W. WASSON

Name of Registered Representative


Signature

July 22, 1999
Date of Signature